

Please cancel claims 13 and 16, without prejudice.

REMARKS

Claims 1-18 are pending in the subject application. Claims 13 and 16 have been cancelled herein, without prejudice. Claims 8 and 11 have been amended. Support for the amendment to claims 8 and 11 is found throughout the Specification and claims, as filed, and no new matter is presented by the amendment.

Favorable reconsideration in light of the remarks which follow is respectfully requested.

1. 35 U.S.C. §112 Rejections

Claims 8, 11, 13 and 15 have been rejected under 35 U.S.C. §112, second paragraph.

Applicants respectfully submit that the amendments made herein render these rejections moot. Reconsideration and withdrawal is respectfully requested.

2. 35 U.S.C. §102 Rejections

Claims 1-18 have been rejected under 35 U.S.C. §102(b) as being anticipated by Futagawa (JP 11-077937).

Applicants respectfully traverse.

Applicants claim, in claim 1, a laminated film produced by a co-extrusion inflation method, comprising an outermost layer (A) comprising a polybutylene terephthalate homopolymer, a polybutylene terephthalate copolymer or a mixture of the polybutylene terephthalate homopolymer and the polybutylene terephthalate copolymer; and the polybutylene terephthalate copolymer and an innermost layer (B) comprising a heat-sealing resin. Further, the outermost layer (A) has a shape factor of

not less than 2.2, which shows a peak shape of Raman spectrum thereof and is represented by formula (1):

$$\text{Shape factor} = L_a/L_b \quad (1)$$

Wherein L_a and L_b represent peak widths being present on higher- and lower-frequency sides, respectively, relative to a perpendicular line drawn from a peak top to a base line formed by a tangent line taken before and after the peak based on carbonyl stretching vibration, and being taken along a horizontal line at a height corresponding to one half of an intensity of the peak.

In the present invention, as a result of analyzing the curling property and Raman spectrum of laminated films, it has been found that when the shape factor of the outermost layer (A) as defined by the above formula (1) is not less than 2.2, the obtained laminated film can be effectively prevented from being curled upon heat-sealing.

JP 11-077937, on the other hand, describes a packaging bag comprising a heat-sealed, unstretched laminated film comprising:

- (A) a blended resin layer comprising a polyethylene naphthalate resin and a polyethylene terephthalate resin, or a polybutylene terephthalate resin layer;
- (B) a gas-barrier resin layer; and
- (C) as an innermost layer, a heat-sealable resin layer.

According to JP 11-077937, the resin layers (A), (B) and (C) are disposed in this order, and resin layer (A) contains an anti-blocking agent composed of organic or inorganic particles.

However, JP 11-077937 does not describe or otherwise suggest that the shape factor of outermost layer (A) is less than 2.2 as required by Applicants' claim 1.

Further, as set out in the attached Declaration of Takashi Futagawa, since the heat-sealed, unstretched laminated films described by JP 11-077937 have a shape factor of 2.05 to 2.14 (See Experiments 2-4), the curling property (the diameter (mm) of

the cylindrical shape or the height (mm)) of the heat-sealed, unstretched laminate film of JP 11-077937 is 18 to 21 mm.

On the other hand, as clearly demonstrated in the Examples of the present invention, the curling property of the present films is no more than 6 mm. Thus, the laminated film of the present invention having an outermost layer (A) with a shape factor of not less than 2.2 has an excellent anti-curling property upon heat-sealing.

As provided in MPEP-2131, a claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegel Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Or stated another way, "The identical invention must be shown in as complete detail as is contained in the ... claims. *Richardson v Suzuki Motor Co.*, 868 F.2d 1226, 9 USPQ 2d. 1913, 1920 (Fed. Cir. 1989). Although identify of terminology is not required, the elements must be arranged as required by the claim. *In re Bond*, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is clear from the foregoing remarks that the above-identified claims are not anticipated by the cited reference. In particular, the cited reference clearly fails to describe a laminated film wherein the outermost layer (A) has a shape factor of not less than 2.2. Further, the Office does not assert that the cited reference describes such a film. Rather, the Office relies on an assertion of inherency and asserts that the "outermost layer inherently has a shape factor of not less than 2.2."

Applicants respectfully disagree.

It is well established that "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or

characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) MPEP 2112.

As clearly demonstrated in the Declaration of Takashi Futagawa, the films described by JP 11-077937 have a shape factor of 2.05 to 2.14, which is not within the presently claimed range of not less than 2.2. Thus, since the allegedly inherent characteristic does not necessarily flow from the teachings of JP 11-077937, these characteristics can not be considered inherent.

Accordingly, reconsideration and withdrawal of the 35 U.S.C. §102 rejections is respectfully requested.

CONCLUSION

Reconsideration and allowance of claims 1-12, 14-15 and 17-18 is respectfully requested in view of the foregoing discussion. This case is believed to be in condition for immediate allowance. Applicant respectfully requests early consideration and allowance of the subject application.

If for any reason a fee is required, a fee paid is inadequate or credit is owed for any excess fee paid, you are hereby authorized and requested to charge Deposit Account No. **04-1105**.

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Should the Examiner wish to discuss any of the amendments and/or remarks made herein, the undersigned attorney would appreciate the opportunity to do so.

Date: 5/6/03

Respectfully submitted,



Lisa Swiszczy Hazzard (Reg. No. 44,368)
Dike, Bronstein, Roberts & Cushman
Intellectual Property Group of
EDWARDS & ANGELL, LLP
P.O. Box 9169
Boston, MA 02209
Tel. No. (617) 517-5512

#334571

VERSION WITH MARKINGS TO SHOW CHANGES MADE IN CLAIMS

Please note that additions to the claims are shown underlined and deletions are shown in brackets.

Please amend claims 8 and 11 as follows:

8. (Amended) A laminated film according to claim [5] 7, wherein said gas-barrier resin layer (C) is formed of polyamide, ethylene-vinyl acetate copolymer saponification product, polyethylene terephthalate, polyethylene naphthalate or polycarbonate.

11. (Amended) A laminated film according to claim 10, wherein [each of] said adhesive resin layer[s] has a thickness of 2 to 30 μm .

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